

Remarks

The Examiner's indication that claims 18, 21, 24, and 25 have been allowed is noted with appreciation. The Examiner's indication that claim 23, although objected to, would be deemed allowable if rewritten in independent form, is also noted with appreciation.

Applicants note that claims 27 and 29 depend from allowable claims 18 and 21 respectively are thus believed to be allowable at least by reason of their dependency from allowable claims 18 and 21.

With this Response, claims 30-33 have been added. No new matter has been added by way of these amendments. Thus, claims 17-33 are pending in the application and are presented for reconsideration and allowance.

35 U.S.C. §103 Rejections

Claims 17, 19, 20, 22, and 26-29 were rejected under 35 U.S.C. §103(a) as being unpatentable over Northrup (U.S. Patent No. 5,972,024) in view of Pyka et al (U.S. Patent No. 5,002,563) and further in view of Krajicek (U.S. Patent No. 5,413,597).

Applicants note as above that claims 27 and 28 depend from allowable claims 18 and 21 and are allowable at least by virtue of their dependency on allowable claims.

The Office Action advanced that Northrup discloses in Figures 4-9 and col. 4, lines 5-54 a clip assembly and a method of holding two tissue parts together where the assembly and method include two clips (60) ...two tissue penetrating needles (40)...and a flexible connector (e.g. 310 in Fig. 9) connecting the other end points of the two clips together; where the method includes penetrating and completely pulling one of the needles through a tissue part (e.g. 320 in Fig. 9) and penetrating an completely pulling the other of the needles through an adjacent tissue part (e.g. also at 320) while the clips are each in an open configuration and pulling the until each of the clips is hooked to a corresponding one of the tissue parts and where the two tissue parts are held together by the flexible connector stretched between the clips.

Contrary to the Office Action assertion, Northrup does not disclose a clip assembly having two tissue penetrating needles and two clips connected by a flexible

connector. In the referenced figure 9, Northrup shows an end-to-end anastomosis being made using two *separate* clip assemblies, each having a single suture 20, a single needle 40, and a single holding device 60. Neither of these clip assemblies has two tissue penetrating needles as recited in independent claims 17 and 20 from which claims 19, 22, 26 and 28 depend either directly or indirectly. Further, the assertion in the Office Action that element 310 (or element 320) in Northrup forms part of the claimed clip assembly appears misplaced. Element 310 and 320 are structures such as vessels, which the two *discrete* clip assemblies join. Neither of these structures form part of a clip assembly. And it would be improper to continue to construe the rejected claims as including body parts. As Applicants set forth in the Amendment and Response of September 2, 2008, elements 310 and 320 are the body parts to which the device of Northrup is applied and are not part of the device of Northrup.

Furthermore, neither Pyka nor Krajicek serve to remedy the deficiencies of Northrup. Even if the clip of Pyka were to be applied to the device of Northrup, there remains a lack of disclosure of a flexible connector connecting two clips. Applicant further submits that there is nothing in Krajicek that suggests adding a prosthesis to either of the clips of Northrup or how such an addition would provide the claimed assembly. Further, the Office Action does not explain how such a modification would be carried out, let alone why one would add a prosthesis to the surgical clip of Northrup. For example, nothing in the Office Action explains how the end-to-end anastomosis method shown in Northrup's figure 9 would be carried out if one were to attach a prosthesis to one of the clips of Northrup. In column 5, lines 32-37, it states: "Once sutures 20 are appropriately placed, sutures 20 can be "parachuted" by pulling the respective vascular structures apart, in order to check for proper positioning and spacing of sutures 20 and/or holding devices 60. This also enables the surgeon to check for crosses, tangles, etc. in sutures 20 themselves."

In view of the foregoing deficiencies in Northrup, the primary reference, and the lack of remedy of these deficiencies from Pyka and Krajicek, a prima facie case of obviousness has not been established. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 17, 19, 20, 22 and 26-29.

CONCLUSION

In view of the above, Applicant respectfully submits that pending claims 17-33 are in form for allowance. Therefore, reconsideration and withdrawal of the rejections and allowance of claims 17-33 are respectfully requested.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 13-2546.

Respectfully submitted,

Date: February 26, 2009

By 
Katrina A. Witschen
Reg. No. 59,862
Patent Attorney
MEDTRONIC, INC.
710 Medtronic Parkway
Minneapolis, MN 55432
Tel. 763-505-8418
Fax. 763-505-8436
Customer No. 77218